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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 09/719,430              | 12/12/2000  | Joshua R. Smith      | 103140-5PCT         | 7630             |
| 7590                    |             | 08/30/2004           | EXAMINER            |                  |
| Cesari & McKenna        |             | KIM, CHONG R         |                     |                  |
| 88 Black Falcon Avenue  |             | ART UNIT             |                     |                  |
| Boston, MA 02210        |             | PAPER NUMBER         |                     |                  |
|                         |             | 2623                 |                     |                  |
| DATE MAILED: 08/30/2004 |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

Best Available Copy

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|------------------------|-------------------------------|----------------------------------|--|
| <b>Advisory Action</b> | Application No.<br>09/719,430 | Applicant(s)<br>SMITH, JOSHUA R. |  |
|                        | Examiner<br>Charles Kim       | Art Unit<br>2623                 |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 24 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: 58,61,67.

Claim(s) objected to: 64.

Claim(s) rejected: 1-57,59,60,62,63,65,66 and 68-83.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

  
Jon Chang  
Primary Examiner

Continuation of 2. NOTE: The proposed amendments require further search and consideration. The applicant's arguments (pages 17-18) with regards to claims 1, 14, and 42 have been considered, but they are not persuasive for at least the following reasons. Applicants argue (page 18) that "The Raterman system is thus an optical pattern reading system for sorting and counting documents, and not a document authentication system. Accordingly, the Raterman system and the Kariakin system operate in entirely different manners and have entirely different objectives." In response to applicant's argument that the Raterman reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kariakin and Raterman are combinable because they are both concerned with optically scanning a workpiece surface for document recognition (and therefore have similar objectives). Furthermore, Kariakin and Raterman both utilize an optical scanning head to achieve this purpose (and therefore operate in a similar manner). Accordingly, the combination of Kariakin and Raterman appear to still be applicable to claims 1, 14, and 42.